



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,272	01/26/2004	Jean-Paul Accarie	02997.002557	6454

5514 7590 06/06/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

MARTINEZ, DAVID E

ART UNIT	PAPER NUMBER
----------	--------------

2181

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,272	Applicant(s) ACCARIE ET AL.	
	Examiner David E. Martinez	Art Unit 2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119


- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/04, 5/12/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


 Supervisor / FRITZ FLEMING
 PRIMARY EXAMINER
 GROUP 2100
 5/14/2006
 10/2181

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claim 38, the use of the term "A computer program product comprising program elements, recorded on a carrier" appears to encompass wireless transmission carriers (signals) which are not concrete and thus directed to non-statutory subject matter. A claim to a proper carrier (i.e. a computer readable medium and not a signal) encoded with functional descriptive material that can function with a computer to effect a useful, concrete and tangible result (e.g. running an assembly line or executing a stock transaction) satisfies the practical application test. The carrier must be limited to a physical structure, not a signal which permits the functionality to be realized within a computer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6, 14-17 and 32-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said device" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said device" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2181

Claim 6 recites the limitation "said device" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 14 and 32 recite the limitation "the analog command signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 15 and 33 recite the limitation "the analog command signal" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 16 and 34 recite the limitation "said analog command signal" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 17 and 35 recite the limitation "said analog command signal" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Please note Claim 1 only recites "analog commands" and not "an analog command signal".

With further regards to claims 16, 17, 34 and 35, the use of the terms "same transmission carrier" and "distinct transmission carriers" render the claims indefinite. It is not understood how the transmission carriers are the same or distinct relative to any other carrier? There is no other instance of a carrier previously being stated in the claims nor is it clear what is the definition of a transmission carrier. Therefore, when transmitting "pieces of data" using the same or a distinct transmission carrier is not understood. Furthermore with claims 16 and 17, the term "pieces of data" also renders the claims indefinite since it isn't clear if only some pieces of data are transmitted, but not the whole entire data comprised of the pieces of data.

Due to the vagueness and a lack of clear definiteness in the claims, the claims have been treated on their merits as best understood by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-3, 8, 12, 13, 16, 18-21, 26, 30, 31, 34, and 36-39 are rejected under 35

U.S.C. 102(e) as being anticipated by US Patent No. 6,639,914 to Choi et al. (hereinafter Choi).

1. With regards to claims 1, 19, 37, 38 and 39, Choi teaches a method for the processing of command signals within an audiovisual network [abstract] comprising at least one element [fig 1 element 10] liable to send a digital command signal [fig 1 element 10 connected to element 20 over an IEEE 1394 digital bus] to at least one peripheral [fig 1 element 30], called an analog peripheral [fig 1 element 30, column 2 lines 41-46], designed to receive analog commands [column 2 lines 41-46], wherein the method implements, in a conversion device [fig 1 element 20], a conversion of said digital command signal into at least one of said analog commands [column 2 lines 41-46], said conversion being selectively configured as a function of said peripheral [column 2 lines 5-20].

2. With regards to claims 2 and 20, Choi teaches a method according to claim 1, wherein said conversion device implements the following steps:

the storage of at least one piece of configuration information representing said peripheral [fig 1 elements 110 and 120, column 2 lines 53-67];

the reception of said digital command signal [column 2 lines 41-46];

the conversion of said digital command signal into an analog command signal taking account of said piece or pieces of configuration information [column 2 lines 5-20]; and

the transmission of said analog command signals to said analog peripheral [column 2 lines 5-20 and lines 41-46].

3. With regards to claims 3 and 21, Choi teaches a method according to claim 2, comprising an initial step for the transmission of said piece of configuration information or said pieces of configuration information of said peripheral to said conversion device [column 2 lines 53-67].

4. With regards to claims 8 and 26, Choi teaches a method according to claim 1, Choi teaches wherein said conversion device is independent [fig 1 element 20 is independent from any other element in figure 1. It is connected over busses to other elements, but it is by itself its own element] of said audiovisual network element or elements [fig 1 element(s) 10] and of said analog peripheral or peripherals [fig 1 element(s) 30].

5. With regards to claims 12 and 30, Choi teaches a method according to claim 1, wherein said digital command signal is of an IEEE 1394 type [column 2 lines 41-46].

6. With regards to claims 13 and 31, Choi teaches a method according to claim 12, comprising a step for the storage of data representing a configuration associated with said peripheral in a directory of said conversion device, said directory being compatible with the ConfigROM IEEE 1394 format [column 2 line 53 to column 3 line 3].

7. With regards to claims 16 and 34, Choi teaches a method according to claim 1, wherein pieces of data associated with said analog command signal are sent to said peripheral on the same transmission carrier [fig 1 element 20 connected to element(s) 30].

8. With regards to claims 18 and 36, Choi teaches a method according to claim 1, wherein said peripheral belongs to the group comprising [please note the alternative language]:

Art Unit: 2181

Camcorders [fig 1 element 30 labeled "camcorder"];
television sets [fig 1 element 30 labeled "Analog TV"];
video recorders [fig 1 element 30 labeled "VCR"];
optical carrier readers; and
set-top boxes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,639,914 to Choi et al. (hereinafter Choi). In view of US Patent Application Publication No. US 2003/0078072 A1 to Serceki et al (hereinafter Serceki).

9. With regards to claims 4 and 22, Choi is silent as to a method according to claim 2, comprising a step for the reading, by said device, of said piece or pieces of configuration information on a detachable data carrier. However, Serceki teaches a device reading a piece or pieces of configuration information on a detachable data carrier for the benefit of avoiding manual entry of complex information thus reducing the chance of errors [paragraphs 6,7,9,10].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Choi and Serceki to have a step for the reading, by said device, of said piece or pieces of configuration information on a detachable data carrier for the benefit of avoiding manual entry of complex information thus reducing the chance of errors.

10. With regards to claims 5 and 23, Serceki teaches a method according to claim 2, wherein said method comprises a step for the reading, by said device, of said piece or pieces of

Art Unit: 2181

configuration information on a detachable data carrier and wherein said reading itself comprises a step for the decoding of mechanical elements belonging to said carrier and representing said peripheral [Serceki paragraph 38] for the same reasons as those set forth in claim 4 above.

11. With regards to claims 6 and 24, Serceki teaches a method according to claim 2, wherein said method comprises a step for the reading, by said device, of said piece or pieces of configuration information on a detachable data carrier and wherein said carrier belongs to the group comprising [please note the alternative language]:

smart cards [Serceki figure 2 element 200];

magnetic carriers [Serceki figs 5a-d element 509 paragraph 38] ; and

optical carriers [Serceki figs 5a-d element 509 paragraph 38] for the same reasons as those set forth in claim 4 above.

Claims 7, 9, 25 and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,639,914 to Choi et al. (hereinafter Choi). In view of US Patent No. 6,823,219 to Lee et al. (hereinafter Lee).

12. With regards to claims 7 and 25, Choi is silent as to a method according to claim 2, wherein said conversion device implements a step to verify the validity of said digital command signal as a function of said piece or pieces of configuration information. However, Lee teaches a device having a set of commands stored in an internal table, the device implementing a step to verify the validity of a digital command signal as a function of a piece or pieces of configuration information for the benefit of preventing the creation of an error condition in a device by checking if a command being used by the device is valid [column 6 line 59 to column 7 line 4].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Choi and Lee to have said conversion device implement a step to

Art Unit: 2181

verify the validity of said digital command signal as a function of said piece or pieces of configuration information for the benefit of preventing the creation of an error condition in a device by checking if a command being used by the device is valid.

13. With regards to claims 9 and 27, Choi is silent as to a method according to claim 1, comprising a step for the storage of at least one piece of conversion information representing a set of commands accepted by said peripheral. However, Lee teaches a step for the storage of at least one piece of conversion information representing a set of commands accepted by a device used to check the validity of a command sent to said device for the benefit of preventing the creation of an error condition in a device by checking against the set of commands in the table, if a command being used by the device is valid [column 6 line 59 to column 7 line 4].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Choi and Lee to have a step for the storage of at least one piece of conversion information representing a set of commands accepted by said peripheral for the benefit of preventing the creation of an error condition in a device by checking against the set of commands in the table, if a command being used by the device is valid.

Claims 10-11 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,639,914 to Choi et al. (hereinafter Choi). In view of US Patent No. 6,823,219 to Lee et al. (hereinafter Lee). in view of US Patent Application Publication No. US 2003/0078072 A1 to Serceki et al (hereinafter Serceki).

14. With regards to claims 10 and 28, the combination of Choi and Lee is silent as to the a method according to claim 9, wherein said pieces of conversion information are transmitted preliminarily by one of said elements of the network to said conversion device. However, Serceki teaches a device reading a piece or pieces of configuration information on a detachable

Art Unit: 2181

data carrier for the benefit of avoiding manual entry of complex information thus reducing the chance of errors [paragraphs 42, 6,7,9,10].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Choi, Lee and Serceki to have said pieces of conversion information be transmitted preliminarily by one of said elements of the network to said conversion device for the benefit of avoiding manual entry of complex information thus reducing the chance of errors.

15. With regards to claims 11 and 29, the combination of Choi and Lee is silent as to method according to claim 9, comprising a step for the reading, by said conversion device, of said piece or pieces of configuration information on a detachable data carrier. However, Serceki teaches a method according to claim 9, comprising a step for the reading, by said conversion device, of said piece or pieces of configuration information on a detachable data carrier for the benefit of avoiding manual entry of complex information thus reducing the chance of errors [paragraphs, 6,7,9,10].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Choi, Lee and Serceki to have a step for the reading, by said conversion device, of said piece or pieces of configuration information on a detachable data carrier for the benefit of avoiding manual entry of complex information thus reducing the chance of errors.

Claims 14, 15, 17, 32, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,639,914 to Choi et al. (hereinafter Choi). In view of Japanese Patent No. JP2002101111A to Takanashi.

16. With regards to claims 14 and 32, Choi is silent as to a method according to claim 1, wherein the analog command signals is of a wireless type. However, Takanashi teaches in a conversion device [fig 1 element 100d], a conversion of a digital command signal [fig 1 element 50 transmits 1394 digital commands to the conversion device] into an analog command signal

Art Unit: 2181

[a wireless/infrared signal - see abstract] for the benefit of enabling electronic peripherals [fig 1 elements 100b and 100c] to receive power-ON commands even if the main power source is OFF and therefore useless power consumption in the entire system is suppressed [see abstract, problem to be solved and advantage section].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Choi and Takanashi to have the analog command signal be of a wireless type for the benefit of enabling electronic peripherals to receive power-ON commands even if the main power source is OFF and therefore useless power consumption in the entire system is suppressed.

17. With regards to claims 15 and 33, Takanashi teaches a method according to claim 1, wherein the analog command signal is of an infrared type for the same reasons as those set forth under the claim 14 rejection above, thus rejected under the same rationale.

18. With regards to claims 17 and 35, Takanashi teaches a method according to claim 1, wherein pieces of data associated with said analog command signal are sent to said peripheral on a distinct transmission carrier for the same reasons as those set forth under the claim 14 rejection above, thus rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application No. US 20030028887 A1 to Frouin et al teaches nodes in a home network working as bridges between digital and analog busses.

US Patent Application No. US 20060007933 A1 to Srivastava which teaches centrally controlling both 1394 and IR devices.

Art Unit: 2181

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Martinez whose telephone number is (571) 272-4152. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fritz M. Fleming can be reached on 571-272-4145. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM

Fritz M. Fleming
Supervisor / FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100
5/24/2006
AU 2181